

## ARGUMENTS

### Rejection of Claims on Art Grounds in the March 1, 2006 Office Action, and Traversal Thereof

The applicant hereby traverses rejections made by the examiner in the  
In the 03/01/2006 Office Action, claims 1-19 were rejected under 35 U.S.C.  
103(a) as being unpatentable over US Patent No. 6,574,645 issued to Petruzzi et al.  
(hereinafter Petruzzi) in view of Pub. No. US 2002/0161733 A1 of Grainger.

#### *Office Action, Item #4:*

Rejections of claims 1-19 are based on § 103(a) as being unpatentable over Petruzzi et al., U.S. Patent No. 6,574,645, for *Machine for Drafting a Patent Application and Process for doing same*, in view of Grainger, Pub. No. 20020161733, for *Method of Creating Electronic Prosecution Experience for Patent Applicant*.

#### The Present Invention Is Not Obvious Over The Cited References

A claimed invention may be found to have been obvious "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). Moreover, the Federal Circuit has ruled on numerous occasions that a holding of "obviousness" requires some motivation, suggestion or teaching within the cited references that would lead one skilled in the art to modify the cited reference or references as claimed by applicant. See, for example, *In re Kotzab*, 217 F3d 1365, 55 USPQ2d 1313 (Fed Cir. 2000):

**"Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or**

teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996)."

The cited references, in particular the main patent reference Petruzzi, describes a system for drafting a patent application, the patent application comprising various components such as claims, specifications, drawings, abstract, title, summary, etc (Petruzzi Fig. 3). The Grainger application describes a client-server system for managing documents in a patent application and prosecution process. The claims of the present application describe a system for drafting a patent application and electronic display of patent-related information based on the technical components of the invention that are different from the specifications, drawings, abstract, title, summary, etc (the components of a patent application). The invention described by Petruzzi pertains drafting a patent application based on user input that is requested by the claimed software tool in a predetermined and fixed sequence and displaying the various components of the patent application (Petruzzi, Fig. 3). The present invention also discloses a software tool. However, the software tool of the present invention as specifically claimed is novel and non-obvious over the cited references.

The Applicant respectfully reasserts that the Examiner's position on combining the references is only possible through hindsight of the present invention, as there is no motivation for combining the cited references. None of the cited prior art applied or not applied, disclose, teach or suggest graphical display and automatic electronic generation of the diagrams based upon technical components of an invention. The present invention

is not merely providing for electronic document comparison, and is not merely providing for patent text generation, as in the case of the prior art cited by the examiner; rather, the present invention provides for automatically generating a viewable diagrammatic representation of components of a technology or a patent application, and their hierarchical relationship. The components of a technology refer to various unique components of the technology or invention. These components have a hierarchical relationship with each other. For example, a technology can be made up of components A, B, C, D and E. Components B and C can be sub-components of component A whereas component D could be a sub component of component C. These components are not the same as components of a patent application (claims, specifications, abstract, etc. of Petruzzi Fig. 3) Therefore, neither Petruzzi nor Grainger, or combination with any other cited references teach or suggest the above, as called for in the independent claims of the present application. Thus, the independent claims along with their dependents cannot be properly held to be obvious over the cited references.

By way of more detailed information, notably, **Petruzzi is not in the same field as the present invention**. Petruzzi discloses a machine for drafting a patent application. The patent application according to Petruzzi has many components (and sub-components). These are abstract, claims, title, list of inventors, etc. of the invention.. Petruzzi focuses on automatically creating a draft for a patent application by collecting the primary elements of an invention in a predetermined sequence, whereas the present invention provides for the analysis and generation of new inventions and patent applications using a fabricated or newly created diagrammatic representation of the components (different from the specifications, claims, abstract, etc) of the invention.

Also, Petruzzi does not automatically generate a diagram of the components of a technology.

Regarding Grainger, it essentially is a client-server based system for tracking the various documents and exchanges during a patent drafting, filing and prosecution process. It does not disclose nor does teach automatically creating a patent application that has a defined hierarchical relationship between various components and subcomponents of the invention.

Neither Petruzzi, nor Grainger teach a way to generate or review a patent application on the basis of a hierarchical relationship between the technical components of the invention disclosed in the patent application. Hence, the claimed subject matter in the Glasgow patent application is not obvious in light of the cited patent and patent application.

The six independent claims and substantive arguments are as follows:

I. Claim 1 (first independent claim)

A. The relevant language from Glasgow is as follows:

- i. *". . . and software installed and capable of running on the at least one computer for automatically generating a diagrammatic representation of an invention, wherein the diagrammatic representation includes a hierarchical component categorization of the technical components of the invention based upon the user inputted information and outputting a viewable diagram of that categorization and for automatically generating a document for filing as a patent application, including specification and claims, based upon the user inputted information and additional text-based detailed information that is organized consistent with the diagram; . . . , wherein the diagrammatic representation of the components and subcomponents together provides an indication of what may be claimed in a patent application."*

B. Considering the emphasized terms above, the present invention is distinguishable from the prior art cited. Neither Petruzzi, nor Grainger do, teach, suggest, or motivate the combination to do these things. Respectfully speaking, the examiner makes a leap of faith and/or rejection based on hindsight by stating the following:

- i. *"Petruzzi teaches a computer system for drafting a patent application including a computer connecting with input devices such as keyboard or mouse and an output device for displaying the information such as display screen device. The computer software installed in the computer for design the a diagrammatic representation of an invention disclosure, which is including patent number, title, inventors, assignee, abstract, drawings, background of the invention, brief summary of the invention, brief description of the drawings and claims (see fig. 1 and 3). Petruzzi does not clearly teach automatically generating a document for filing as a patent application, including specifications and claims, based upon the user inputted information and additional text based detailed information that is organized consistent with the diagram. However, Grainger teaches a patent application or an intellectual property document (invention discloses [sic]) is automatically created (fig. 1, document for filing as a patent application including abstract, drawings, ... claims, is generated and file [sic] at patent office such as USPTO: sections 0004-0010 and 0092-0094). Therefore, it would have been obvious... to combine the teachings of Petruzzi with the teachings of Grainger"*
- ii. It does not follow that combining Petruzzi and Grainger would yield a viewable, hierarchical diagram based on the technical components of an invention that could automatically generate a document for filing as a patent application, and *there is no motivation in either reference to make the present invention as claimed. Therefore, the examiner's rejection was made improperly in hindsight of the present invention. The technical components of an invention are components that are not the same as the components of a patent application in Petruzzi (Fig. 3).*

C. The following are key quotes from Glasgow that further substantiates the above argument. Terms representing important distinctions over the prior art are emphasized.

- i. *The software of the present invention is designed and configured to provide a graphical interface for diagramming the structure of intellectual property in a patent application or for assessment of technology or issued patents and for automatically creating text-based description linked to components in the diagram, indicating their hierarchical relationship, and integrating those descriptions into a coherent specification and claims of a patent application.*
- ii. *The software of the system according to the present invention is designed and established to aid in diagramming intellectual property, displaying and manipulating the diagram in a way helpful to the patent drafters and clients, and converting the diagram into an actual patent application.*
  1. *The diagram itself takes the form of a data tree.*
  2. *This linked tree structure enables elements to be easily moved, sorted, and graphically rendered with a minimum of processing delay and memory usage.*

II. Claim 11 (second independent claim)

A. This claim is a method claim developed from Claim 1. The above arguments should be applicable to this claim as well.

III. Claim 16 (third independent claim)

A. This claim is directed at the embodiment of the Glasgow invention concerning with a system for mapping technology. The above arguments should be application to this claim as well.

B. The relevant language from Glasgow is as follows:

- i. “... software installed and capable of running on the at least one computer for automatically generating a diagrammatic representation of a technology, wherein the diagrammatic representation includes a hierarchical component categorization of the technical components of the technology based upon the user inputted information and outputting a viewable diagram of that categorization; wherein the hierarchical component categorization includes at least one key component and at least one subcomponent related thereto.”

C. Considering the emphasized terms above the present invention is distinguishable from the prior art cited. Neither Petruzzi, nor Grainger do, teach, suggest, or motivate the combination to do these things.

Respectfully speaking, the examiner makes a leap of faith and/or rejection based on hindsight by stating the following:

- i. "Petruzzi does not clearly teach automatically generating a diagrammatic representation of a technology. However, Grainger teaches a patent application or an intellectual property document (invention discloses [sic]) is automatically created (fig. 1, document for filing as a patent application including abstract, drawings, ... claims, is generated and file at patent office such as USPTO: sections 0004-0010 and 0092-0094). Therefore, it would have been obvious to a person or ordinary skill in the art at the time the invention was made to combine the teachings of Petruzzi with the teachings of Grainger wherein the patent application's diagrammatic representation of components and subcomponents in the system provided therein (Petruzzi's Fig. 3)...."
- ii. It does not follow that combining Petruzzi and Grainger would yield an automatically generated viewable, hierarchical diagram based on the technical components of a technology, and *there is no motivation in either reference to make the present invention as claimed. Therefore, the examiner's rejection was made improperly in hindsight of the present invention. The technical components and subcomponents of an invention are not the same as the components of a patent application in Petruzzi (Fig. 3). The components and subcomponents in Glasgow are elements of an invention and not sections of a patent application as in Petruzzi.*

IV. Claim 17 (fourth independent claim)

- A. This claim is a method claim developed from claim 16. The arguments for claim 1 and claim 16 should be applicable to this claim as well.

V. Claim 18 (fifth independent claim)

- A. This claim is directed at the embodiment of the Glasgow invention concerning with a system for examining a patent application. The above arguments should be application to this claim as well.

B. The relevant language from Glasgow is as follows:

- i. "... software installed and capable of running on the at least one computer for automatically generating a diagrammatic representation of a technology, wherein the diagrammatic representation includes a hierarchical component categorization of the technical components of the technology based upon the user inputted information and outputting a viewable diagram of that categorization; wherein the hierarchical component

categorization includes at least one key component and at least one subcomponent related thereto; and the atleast one user viewing the diagram and text-based information in a tangible medium.”

C. Considering the emphasized terms above the present invention is distinguishable from the prior art cited. Neither Petruzzi, nor Grainger do, teach, suggest, or motivate the combination to do these things. Respectfully speaking, the examiner makes a leap of faith and/or rejection based on hindsight by stating the following:

- i. “Petruzzi does not clearly teach automatically generating a diagrammatic representation of a technology. However, Grainger teaches a patent application or an intellectual property document (invention discloses [sic]) is automatically created (fig. 1, document for filing as a patent application including abstract, drawings, ... claims, is generated and file at patent office such as USPTO: sections 0004-0010 and 0092-0094). Therefore, it would have been obvious to a person or ordinary skill in the art at the time the invention was made to combine the teachings of Petruzzi with the teachings of Grainger wherein the patent application’s diagrammatic representation of components and subcomponents in the system provided therein (Petruzzi’s Fig. 3)....”

D. It does not follow that combining Petruzzi and Grainger would yield an automatically generated viewable, hierarchical diagram based on the technical components of a technology, and there is no motivation in either reference to make the present invention as claimed. Therefore, the examiner’s rejection was made improperly in hindsight of the present invention. The technical components and subcomponents of an invention are not the same as the components of a patent application in Petruzzi (Fig. 3). The components and subcomponents in Glasgow are elements of an invention and not sections of a patent application as in Petruzzi.

VI. Claim 19 (sixth independent claim)

- A. This claim is a method claim developed from claim 18. The arguments for claim 1 and claim 18 should be applicable to this claim as well.

Claims 6 -10 and 12-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,574,645 issued to Petruzzi in view of Pub. No. US

2002/0161733 A1 of Grainger. As the independent claims have been argued to be distinguishable from Petruzzi, the claims 6-10 and 12-15, under the same arguments are now asserted to be allowable.

Applicant asserts that the prior art reference cited by the examiner does not anticipate the claims. The above rejections of the claims 1- 19 on the stated art grounds are traversed, and consideration of the patentability of the claims 1- 19, now amended, is requested, in light of the foregoing remarks.

Applicant notes that the present invention was found to be novel non-obvious and has been issued as a patent in several foreign countries.

### CONCLUSION

In view of the foregoing, claims 1- 19, presently amended, constituting the claims pending in the application, are submitted to be fully patentable and in allowable condition to address and overcome the rejections. If any issues remain outstanding, incident to the allowance of the application, Examiner Ly is respectfully requested to contact the undersigned attorney at (919) 664-8222 or via email at [jinang@trianglepatents.com](mailto:jinang@trianglepatents.com) to discuss the resolution of such issues, in order that prosecution of the application may be concluded favorably to the applicant, consistent with the applicant's making of a substantial advance in the art and particularly pointing out and distinctly claiming the subject matter that the applicant regards as the invention.

This response is submitted as a Request for Continued Examination via facsimile to the USPTO Central Official Fax number 571.273.8300 on June 30, 2006, with a request for extension of time for one month, and payment of the fees therefor.

Respectfully submitted,



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